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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,202	02/01/2001	Johnny B. Corvin	UV-181	7104

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EXAMINER	
BELIVEAU, SCOTT E	

ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/775,202	CORVIN ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,6-18,35,36,40-48,60 and 61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,6-18,35,36,40-48,60 and 61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e).

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

2. The disclosure of the prior-filed application, Application No. 60/179,548, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application as follows:

- The provisional application fails to suggest that the "promotion is selected based upon the content of the program" as recited in claims 2 and 36;
- The provisional application fails to provide adequate support for "recording a flag with the promotion to indicate the beginning of the program during playback" as recited in claims 8 and 41;
- The provisional application fails to suggest that the "promotion is recorded at any desired point within the program" recited in claims 11 and 44;

- The provisional application fails to provide support for the particular method of distribution of the program, the promotion, and the program guide over either a "single broadcast channel" or a "plurality of broadcast channels" as recited in claims 14, 15, 46, and 47;
- The provisional application does not disclose details regarding the storage of the program, the promotion, and the program guide data with a "storage unit" or a "plurality of storage units", as recited in claims 16, 17, and 48.
- The provisional application does not disclose details regarding the program, the promotion, and the television program guide data being received on-demand from a television distribution facility as recited in claim 60.

Accordingly, claims 2, 8, 11, 14-17, 36, 41, 44, 47-48, and 60 do not receive the benefit of priority and are being examined on the basis of the application filling date or 01 February 2001.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 2, 6-18, 35, 36, 40-48, and 60-61 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claim 60 is objected to because the phrase "he program" should read "the program". Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 6, 12, 13, 16, 18, 35, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US Pat No. 5,353,121) in view of Goldschmidt Iki et al. (Us Pat No. 6,483,987).

In consideration of claims 1 and 35, the Young et al. reference discloses a "system" and "method" for "providing an integrated recorded program/promotion playback asset". The system/method comprises a "user input device" [130] "configured to receive a user input to select a television program to be recorded" [148] (Figure 21). The "user equipment" (Figure 22B), "receives a selected program" [207/268], "determines whether the selected program is to be recorded" [220], and "in response to determining that the selected program is to be

recorded: records the selected program for inclusion in the integrated program/promotion playback asset" [252] (Col 8, Line 36 - Col 9, Line 8; Col 19, Lines 1-13). Subsequent to recording the program, the system "plays back the recorded program/promotion playback asset in response to receiving a user indication to playback the recorded program" (Col 19, Lines 53-61). The reference, however, does not explicitly disclose nor preclude the further "selection", "recording", and "playback" of a "promotion" in conjunction with the recorded program.

In an analogous art pertaining to the recording of television programs the Goldschmidt Iki et al. reference, discloses a video recording/playback device [122] that allows for the selective recording of "promotions" within the received broadcast stream. Subsequently, "in response to determining that [a] selected program is to be recorded: [the system] record[s] the selected program for inclusion in the integrated recorded program/promotion playback asset, select[s] a promotion to record for inclusion in the integrated recorded program/promotion playback asset; and record[s] the selected promotion for inclusion in the integrated recorded program/promotion playback" (Figures 5-8; Col 8, Line 59 – Col 10, Line 5). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Young et al. to allow for the automatic recording of programming either with or without commercials (Goldschmidt Iki et al.: Col 1, Lines 19-46).

Claim 6 is rejected wherein the method further comprises "recording both the program and the promotion on a storage unit" [252] or VCR (Young et al.: Figure 22B).

Claim 12 is rejected wherein the method comprises "receiving the program and the promotion" (Goldschmidt Iki et al.: Col 3, Lines 3-9).

Claim 13 is rejected wherein the method further comprises "receiving program guide data" (Young et al.: Col 18, Lines 37-55).

Claim 16 is rejected wherein the method further comprises "storing the program, the promotion, and the program guide data" (Young et al.: Col 18, Lines 37-55; Col 19, Line 62 – Col 20, Line 13).

Claim 18 is rejected wherein the "program the promotion, and the program guide data are stored on a plurality of storage units" (ex. RAM [232] and VCR tape [252]).

Claim 45 is rejected wherein the system further comprises a "receiver that receives signals and data" [207] (Young et al.: Figure 22B).

Claim 48 is rejected wherein the system further comprises a "storage unit" or VCR [252] "that stores the program and the promotion" (Young et al.: Figure 22B).

8. Claims 2, 7-11, 14, 15, 17, 36, 40-44, 46, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US Pat No. 5,353,121), in view of Goldschmidt Iki et al. (Us Pat No. 6,483,987), and in further view Zigmond et al. (US Pat No. 6,698,020).

Regarding claims 2 and 36, the combination of references is silent with respect to the "promotion [being] selected based upon the content of the program". In an analogous art pertaining to the field of 'promotions', the Zigmond et al. reference teaches that video programming typically already include commercials (Figures 2A/B) and that commercials may be recorded (Col 14, Lines 12). These "promotions [are] selected based upon the content of the program" (Col 12, Line 60 – Col 13, Line 6). Accordingly, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to modify the combined references to utilize the teachings of Zigmond et al. for the purpose of providing a means to specifically target, deliver, and present individually targeted advertisements to viewers regardless of the source of the media in order to effectively reach the consumer (Zigmond et al.: Col 3, Line 45 – Col 4, Line 3).

In consideration of claims 7, 9-11, 40, and 42-44, the Zigmond et al. reference discloses that "promotions" may be displayed either so as to replace existing advertisement slots or may be placed at any point in the programming. Accordingly, during the recording of such a program a promotion would be "recorded" at the "beginning of the program", the "end of the program", the "beginning and the end of the program", or "at any desired point within the program" (Zigmond et al.: Col 14, Lines 1-12; Col 16, Lines 20-43). Similarly, the playback of the aforementioned recorded media may have commercials "integrated" at different points in time.

Claims 8 and 41 are rejected wherein the Young et al. reference is operable to "record a flag . . . to indicate the beginning of the program during playback" so as to locate the beginning of a particular program (Col 19, Lines 46-61).

Claims 14, 15, 46, and 47 are rejected wherein the "program, the promotion, and the program guide data are received" either via a "single broadcast channel" or via a "plurality of broadcast channels" (Zigmond et al. Col 7, Lines 1-25; Col 14, Line 66 – Col 15, Line 16)(Young et al.: Col 18, Lines 37-55).

9. Claims 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US Pat No. 5,353,121), in view of Goldschmidt Iki et al. (Us Pat No. 6,483,987), and in further view of Michaud (WO 99/57904 A1).

Regarding claims 60 and 61, the combination of reference teach that the 'receiver' [207/268] receives 'signals' or "the program and the promotion . . . on-demand" in accordance the user's instructions/request to record the program distributed "from a television distribution facility" (ex. cable provider or broadcaster). The combination, however, is silent with respect to the 'program guide data' being similarly received. In an analogous art pertaining to interactive video distribution, the Michaud reference discloses a system and method for "receiving . . . . program guide data . . . on-demand from a television distribution facility" (Figure 3). Accordingly, it would have been obvious to one having ordinary skill in the art to modify the combined references to receive program guide data 'on-demand' for the purpose of minimizing the usage of local memory in the user equipment in order to reduce the cost of the equipment (Michaud: Page 3, Lines 24 – Page 4, Line 8).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott Beliveau
Primary Examiner
Art Unit 2623

SEB
January 28, 2008